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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,058	11/29/2000	Benjamin N. Truelove	MICR0519	8668

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EXAMINER
VAUGHN, GREGORY J

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 05/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)	
Office Action Summary		09/726,058	TRUELOVE ET AL.	
		Examiner	Art Unit	
		Gregory J. Vaughn	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>03 March 2006</u>.

2a)☐ This action is **FINAL**.　　2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,7-13 and 15-23* is/are pending in the application.

　　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,7-13 and 15-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All　b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Application Background

1.   This action is responsive to the Request for Continued Examination, filed on

3/3/2006.

2.   Applicant has cancelled claims 6 and 14, and amended claims 1, 5, 8, 11-13, 15,

16, 18 and 20-22.

3.   Claims 1-5, 7-13 and 15-23 are pending in the case, claims 1, 13 and 22 are

independent claims.

4.   A request for continued examination filed under 37 CFR 1.114, including the fee

set forth in 37 CFR 1.17(e), was filed in this application after a final rejection. Since

this application is eligible for continued examination under 37 CFR 1.114, and the

fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous

Office Action (dated 12/14/2005) has been withdrawn pursuant to 37 CFR 1.114.

5.   Examiner's rejection of claims 1-23, made under 35 USC 112 in the *Claim*

Rejections – 35 USC 112 section of the previous office action (dated 12/14/2005) is

withdrawn in view of the claim amendments and applicant's remarks.

6.   Examiner's rejection of claims 6 and 14, made under 35 USC 103, as recited in

the previous office action (dated 12/14/2006) are withdrawn in view of the cancelled

claims.

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> *"(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."*

8.   Claims 1-5, 7-13 and 15-23 remain rejected under 35 U.S.C. 103(a) as being

unpatentable over Russo Borland, "Running Microsoft Word 97", Published by

Microsoft Press, Redmond, Washington USA, 1997. *"Russo Borland"* (herein after

"Borland") in view of Parker et al. US Patent RE 36,704, filed 11/16/1995, patented

5/16/2000 (herein after *"Parker"*).

9.   **Regarding independent claim 1**, the Borland reference is a training manual for

the Microsoft Word 97 word processing software. Borland describes the steps taken

by a user of the Word 97 software to reformat previously formatted portions of

document text, on pages 35-68, under the heading *Format*. Borland discloses

determining a sample of formats comprising a plurality of formats form a format set,

where the format set includes a font set and a color set. Borland discloses the use of

format "*Styles*" in the figure on page 60. The figure discloses a plurality of format

styles and related samples. Each style has font and color settings; see Figure 2-5 on

page 43 for examples of color and font settings related to styles. Borland discloses

each font set including a plurality of fonts defining a font theme, and each of the formats includes a font name, font color and font size. Borland recites: "*Improving the looks of characters means adding decorative touches to the basic appearance of words—selecting the font name, style, size, and colors*" (page 42, second paragraph).

Borland discloses identifying a portion of text to be reformatted. Borland recites: "*To simply have Word apply a format to your document quickly after you're done adding text, set an insertion point in the document (or select a portion of the document if you want to decorate only that portion)*" (page 37, second paragraph). Borland discloses reformatting the text and displaying the result in a live preview window. Borland discloses reformatted text in a preview window in figure 2.5 on page 43 and the figure on page 60.

Borland fails to disclose simultaneously displaying each of the reformatted text portions in live preview windows in order that a user can visually compare how each portion of text will appear in each of the formats. Parker teaches the simultaneous display of text portions for comparison by a user in Figure 6a at reference sign 610 (shown on the right hand side of the figure as four simultaneously displayed previews).

Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made, to combine the reformatting of Borland with the simultaneous display taught by Parker in order to "*produce user documents with a user selected typeface in a user selected format*" (Parker, column 1, lines 16-17).

10.   **In regard to dependent claim 2**, the claim is directed toward a computer readable medium with computer executable instructions. Borland discloses reformatting documents as described above. Borland fails to explicitly describe a computer readable medium with instructions, but Borland describes common computer environment capabilities, like saving files (page 132), creating folders (page 133) and exiting applications (page 150).

Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made, to use the teachings of Borland on a computer system, because document format management is typically implemented on a computer system to allow instantaneous document reformatting capabilities.

11.   **In regard to dependent claim 3**, Borland discloses selecting a color and font that determines a format set in the first figure on page 43. The user would select the "Ok" button in the dialog window shown in the first figure on page 43 to determine the selected format set.

12.   **In regard to dependent claims 4 and 5**, Borland discloses a trained designer defining color schemes (claim 4) and font themes (claim 5). Borland discloses a "*Hiring a Decorator: AutoFormat*" section of his manual, starting on page 35 (second paragraph). Borland also recites: "*Improving the looks of characters means adding decorative touches to the basic appearance of words—selecting the font name, style, size, and colors*" (page 42, second paragraph).

13.   **In regard to dependent claim 7**, Borland discloses a preview window displayed

above the document. Borland discloses a preview window dialog box in the figure on

page 61. Window's Dialog boxes are displayed above the parent application (in this

case the Word document).

14.   **In regard to dependent claim 8**, Borland discloses receiving a command to add

a custom format in the figure on page 60 (see the "*New*" button shown in the figure).

Borland discloses adding the custom format to the sample of formats. Borland

describes the steps to add a custom format (described as "*Styles*") on pages 826 to

842. Specifically the dialog box on page 830 (the upper figure on the page) shows

the basic custom font-specifying tool, where the user would select the "*Ok*" button to

add the custom format to the sample of formats. Borland discloses reformatting the

live preview text with the custom format and displaying the reformatted live preview

text in the live preview window. Borland discloses a custom format (shown as

"Invite") used to reformat a section of live preview text, which is displayed in a live

preview window in the figure on page 834.

15.   **In regard to dependent claim 9**, Borland discloses a user defined custom

format. Borland describes the steps for a user to add a custom format (described as

"Styles") on pages 826 to 842.

16.   **In regard to dependent claim 10**, the claim contains substantially the same

subject matter as claim 2, and is rejected with the same rationale.

17.   **In regard to dependent claims 11 and 12**, Borland discloses identifying the portion of text to be reformatted constrained to a portion of text disposed immediately adjacent to a cursor position (claim 11) by text that has been highlighted (claim 12). Borland recites: *"To simply have Word apply a format to your document quickly after you're done adding text, set an insertion point in the document (or select a portion of the document if you want to decorate only that portion)"* (page 37, second paragraph). Borland discloses the live preview text being constrained to a portion of text disposed immediately adjacent to a cursor position in a document in the figure on page 51, in the Preview window shown at the bottom of the dialog box. Although not shown in this example, the cursor had been previously placed immediately adjacent to the "Wild Ride" text of the example document, which has caused the live preview to be constrained to that portion of document text.

18.   **In regard to independent claim 13**, the claim is directed to a system for performing the method of claims 1 and 3 combined, and is rejected with the same rationale. Claim 13 also adds the limitation wherein the formats are not applied to the portion of text until after a user selects a format to apply after previewing the portion of text in the live preview window. Borland discloses the live preview window in the figure on page 60 (shown as *Paragraph Preview* and *Character Preview*). Borland discloses an *Apply* button on the control that the user would select after the preview of the portion of text was complete.

19.   **In regard to dependent claim 15**, the claim is directed to a system for performing the method of claim 4, and is rejected with the same rationale.

20.   **In regard to dependent claim 16**, the claim is directed to a system for performing the method of claim 5, and is rejected with the same rationale.

21.   **In regard to dependent claim 17**, the claim is directed to a system for performing the method of claim 7, and is rejected with the same rationale.

22.   **In regard to dependent claim 18**, the claim is directed to a system for performing the method of claim 8, and is rejected with the same rationale.

23.   **In regard to dependent claim 19**, the claim is directed to a system for performing the method of claim 9, and is rejected with the same rationale.

24.   **In regard to dependent claim 20**, the claim is directed to a system for performing the method of claim 11, and is rejected with the same rationale.

25.   **In regard to dependent claim 21**, the claim is directed to a system for performing the method of claim 12, and is rejected with the same rationale.

26.   **In regard to independent claim 22**, the claim is directed to a user interface for performing the method of claims 1 and 3 combined, and is rejected with the same rationale.

27.   **In regard to dependent claim 23**, the claim is directed to a user interface for performing the method of claim 8, and is rejected with the same rationale.

Response to Arguments

28.   Applicant's arguments, filed 3/3/2006, with respect to the 35 USC 112 rejections have been fully considered and they are persuasive. The rejections made under 35 USC 112 are withdrawn, as described above.

29.   Applicant's arguments, filed 3/3/2006, with respect to the 35 USC 103 rejections have been fully considered but they are not persuasive.

30.   **Regarding independent claim 1,** applicant states that: *"the cited art does not teach or suggest ... (1) a format set and (2) a plurality of fonts defining a font theme"* (page 7 last paragraph, of the response filed 3/3/2006). In response to these arguments the applicant is directed to the rejection of claim 1 as stated above. Borland discloses a format set as claimed by applicant. Borland shows the style feature of Word 97 in the figure on page 60. These styles are a format set. Applicant defines a format set as *"at least one font set and at least one color set"* (claim 1). Borland discloses that the styles are related to at least one font set and at least one color set in Figure 2.5 on page 43 (the *Modify* button of the figure on page 60 would provide access to the font controls shown in figure 2.5).

Applicant has recited from the originally filed specification to identify an example related to the definition of the format set (bottom of page 8 to the top of page 9, of the response filed 3/3/2006) that shows the format set having a name (Curly-Q Ocean), and implies that the format set is different from a *Style* format set, as disclosed by Borland. However these features (i.e. a format name and a format set

that is different from the *Style* format set) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
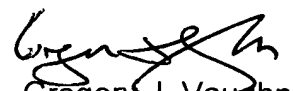
Borland's figure on page 60 also discloses a font theme. In the figure, various styles are shown in the "*Styles*" list box (on the left side of the figure). The naming of various styles with theme related names is shown (i.e. "*List Number*", "*List Number 2*", "*List Number 3*", "*List Number 4*", etc.).

Conclusion

31.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory J. Vaughn
Patent Examiner
May 25, 2006